

REMARKS**Status of the Claims**

Upon entry of the amendment above, claims 2-13, 15, 17-20, 24-27, 29, 30, and 33-38 be pending, claim 24 being the only independent claim. Claims 19 and 20 have been withdrawn from consideration by the Examiner.

Summary of the Office Action

Claims 19 and 20 stand withdrawn from consideration as being directed to an embodiment of the invention that was non-elected in response to the Examiner's previously imposed restriction requirement.

All claims are rejected under 35 USC §101 as being directed to non-statutory subject matter for allegedly "reciting a part of the human body."

Claims 2-13, 15, 17, 18, 24-27, 29, 30, and 33-35 are rejected under 35 USC §112, second paragraph, as being indefinite.

Claims 2-12, 15, 17, 18, 24-27, 29, 30, 34, and 35 are rejected under 35 USC §103(a) as being unpatentable over HOSHIZAKI et al. (U.S. Patent No. 5,498,033, hereinafter "HOSHIZAKI").

Claims 13 and 33 stand rejected under 35 USC §103(a) as being unpatentable over HOSHIZAKI in view of BOURDEAU (U.S. Patent No. 5,887,886).

Response to the Office Action**A. Withdrawal of Rejection Under 35 USC §101**

In view of the fact that Applicant is not claiming a part of the human body, reconsideration and withdrawal of the rejection under 35 USC §101 is requested.

Although the rejection is not specific as to which part of the human body claim 24 "positively recites", Applicant does not intend to positively recite a part of the human body.

Further, Applicant has amended independent claim 24 to specify, with the addition of several words, but perhaps with more clarity nevertheless, that any recitation of a part of the foot of a wearer of the boot of the invention is not an attempt to have the USPTO issue a patent in violation of 35 USC §101.

Claim 24 makes reference to the following parts of a human body: foot, lower leg, ankle, and metatarsophalangeal joint. Dependent claim 13 makes reference to the tibia.

Applicants have not invented any of these portions of the human body and, therefore, requests that the Examiner interpret the claim(s) in such a manner.

Line 3 of claim 24 references both the foot and the lower leg of the user of the boot of the invention. However, in line 3 of claim 24, Applicant intends merely to specify that the external upper covers the foot and the lower leg; Applicants submit that line 3 does not specify that the upper comprises or includes the foot or the lower leg.

Line 6 of claim 24 references the ankle of the user of the boot of the invention. However, in line 6 of claim 24, Applicant intends merely to refer to the dorsal portion of the flexible frame of the upper as extending upwardly above an area that is adapted to cover the ankle of the user.

Line 7 of claim 24 references the rear of the lower leg of the user of the boot of the invention. However, in line 7 of claim 24, Applicant intends merely to refer to the dorsal portion of the flexible frame of the upper as covering (*i.e.*, lying against) the rear of the lower leg of the user.

Line 12 of claim 24 references the metatarsophalangeal joint of the user's foot. However, in line 12 of claim 24, Applicant intends merely to refer to a part (*i.e.*, "another part") of the lateral portion of the flexible frame as being adapted to cover the metatarsophalangeal joint of the foot of the user.

In view of the amendment to claim 24 and Applicants' foregoing comments, reconsideration and withdrawal of the rejection under 35 USC §101 is requested.

Further, in the event the Examiner were to prefer different wording for the purpose of overcoming the §101 rejection, she is kindly requested to contact Applicant's undersigned representative so that the issues presented in this rejection can be resolved before allowance or appeal.

B. Withdrawal of Rejection Under 35 USC §112, Second Paragraph

Reconsideration and withdrawal of the rejection under 35 USC §112, second paragraph, is kindly requested.

First, in the amendment of claim 24 above, all occurrences of "external sole" have been changed to "outer sole" for consistency and for thereby providing proper antecedent bases.

Second, although Applicant submits that his specification and drawings provide a disclosure whereby the later portion of the flexible frame can be both connected to the sole and spaced above the sole (*i.e.*, with reference to different parts of the lateral portion), Applicant has amended claim 24 to refer, firstly, to "a part" of the lateral portion of the flexible frame (which is spaced above the outer sole) and "another part" of the lateral portion of the flexible frame (which is connected to the outer sole).

In view of the amendment, reconsideration and withdrawal of the rejection is requested.

C. Withdrawal of Rejection Under 35 USC §103(a) Based Upon HOSHIZAKI

Applicant requests that the rejection of claims 2-12, 15, 17, 18, 24-27, 29, 30, 34, and 35 under 35 USC §103(a), based upon HOSHIZAKI, be withdrawn.

Among other limitations, independent claim 24 includes the following: (a) at least the lateral portion of the flexible frame (such as lateral arm 15 (see, *e.g.*, Fig. 4 or Fig. 7)) is spaced above the outer sole of the boot of the invention; (b) the lateral portion of the flexible frame is connected to the outer sole of the boot of the invention proximate an area of the metatarsophalangeal joint; and (c) the flexible frame extends above the ankle region of the boot. (A fourth feature, *i.e.*, the flexible frame not extending through a lower surface of the outer

sole, previously specified in claim 24, has been relegated to dependent claims 36-38 by amendment above.)

In addition, claim 24 specifies that the frame is a *flexible* frame, *i.e.*, one that can be flexed (not a *rigid* frame as in BOURDEAU, nor a frame intending merely *rigidify* the heel of the boot as in HOSHIZAKI).

HOSHIZAKI is directed to a skate boot especially used for hockey. The invention of HOSHIZAKI preferably includes an injection molded plastic overlay that is intended to increase the rigidity of the rear of the skate (see column 2, lines 12-16 and 42-44).

Side panels 7 of HOSHIZAKI's plastic overlay are at the *rear*, not at the *metatarsophalangeal joint*, as specified in Applicant's claim 24. This difference is more than a mere obvious matter of design. The location of the lateral portion of the flexible frame according to Applicant's invention is important for an optimum transmission of the forces that are generated during use of the boot, as explained by Applicant on page 6, lines 11-13, of the specification, for example.

In the rejection, the Examiner explains that "[w]ith regard to the location of where the lateral arm is fixed to the outer sole, this will depend on the size and shape of the foot of the user. The location of the metatarsophalangeal joint will depend on the size and ~~ten~~ shape of each individual user and will vary from one user to another."

To the extent that this explanation is directed to the limitation in Applicant's claim 24 regarding the connection of the flexible frame proximate an area adapted to cover the metatarsophalangeal joint, the explanation is not correct. The metatarsophalangeal joint is, by definition, at the point along the foot at which the metatarsus bones and the bones of the phalanges connect. Although the size and shape of one person's foot differ from that of another person, the boot of the invention, as specified in claim 24, for example, encompasses a boot that would be worn by a person in the ordinary and customary manner.

Further in this regard, Applicant directs attention to Attachments A and B. Attachment A is Sheet 2 of 6 of HOSHIZAKI (showing Fig. 2) and Attachment B is a diagram representing the bones of the foot, taken from the website www.footmaxx.com/clincians/bones.html. By superimposing Attachment A over Attachment B, one can see that the joints connecting the metatarsals (identified by reference numerals 8-12) and the phalanges (identified by reference numeral 13), would be positioned in the boot of HOSHIZAKI in an area substantially forward of side panel element 7 of HOSHIZAKI (identified in the rejection as corresponding to Applicant's claimed "lateral arm") and, more particularly, in an area of the HOSHIZAKI boot that would be beneath the first few lace eyelets shown in HOSHIZAKI's Fig. 2.

It can be readily appreciated that if the side panel 7 of HOSHIZAKI were to be located in an area corresponding to the metatarsophalangeal joint, it must be moved forwardly a distance greater than the distance panel 7 is presently from the rear of the boot.

Clearly, such a modification would be contrary to the teachings of HOSHIZAKI in which, *e.g.*, HOSHIZAKI explains that the plastic overlay 1, of which side panel 7 is a part, "is preshaped to approximately the shape of the boot *heel*" (emphasis added).

Thus, rearranging the position of the side panel 7 in a manner that would have resulted in a location proximate an area adapted to cover the metatarsophalangeal joint of the user's foot would not have been obvious and would be contrary to the teaching of HOSHIZAKI.

Still further, column 2, lines 42-47 of HOSHIZAKI explain that the rigid side panels 7 "prevents or restricts pronation and supination" of the rear of the skate. If the side panels were to have been moved significantly forward to the point that they would be proximate an area of the metatarsophalangeal joint, the objective of preventing or restricting pronation and supination of the rear of the skate would be compromised.

As explained in *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), a proposed modification is inappropriate as a consideration regarding obviousness under 35 USC §103 when such modification rendered the prior art reference inoperable for its intended purpose.

At least for the foregoing reasons, reconsideration and withdrawal of the rejection based upon HOSHIZAKI is requested.

D. Withdrawal of Rejection Under 35 USC §103(a) Based Upon HOSHIZAKI in View of BOURDEAU

Applicant requests that the rejection of claims 13 and 33 under 35 USC §103(a), based upon HOSHIZAKI and BOURDEAU, be withdrawn.

BOURDEAU is directed to a sport boot having a sole and an attachment member (elements 31, 32) affixed to the sole against movement with respect to the sole. The boot comprises an upper having a rigid internal skeleton extending from a portion of the sole and upwardly at least along a lateral side of the boot. The skeleton constitutes a minimal energy circuit for the transmission of forces and support, such circuit passing through the attachment means of the boot.

Independent claim 24 is directed to a sports boot that includes an outer sole and an external upper, the upper including a *flexible frame* that made of a substantially *non-stretchable material*. Both HOSHIZAKI and BOURDEAU are directed to rigidifying structures. HOSHIZAKI is concerned with rigidifying the rear of the boot, from the heel to ankle region thereof (see column 1, lines 36-37). HOSHIZAKI's invention is directed to a rigidifying, preferably molded plastic, overlay for the heel of a skate.

Dependent claim 13, rejected upon an alleged obvious combination of HOSHIZAKI and BOURDEAU, specifies that the flexible frame extends above the ankle region to about a middle region of a tibia of the user. Applicant submits that the plastic overlay of HOSHIZAKI does not extend above the ankle region of the skate; instead, the overlay is *in* the ankle region. In HOSHIZAKI, it is important to allow plantar flexion (column 1, lines 31-33) and, Applicant respectfully submits, it would not appear to one skilled in the art that extending the plastic overlay upwardly further than disclosed by HOSHIZAKI would be consistent with that objective.

Therefore, Applicant would submit that one skilled in the art would not consider modifying the height of the frame of HOSHIZAKI, by means of a teaching from BOURDEAU or otherwise, in a manner that would have resulted in Applicant's invention as specified in rejected claim 13.

Dependent claim 33, also rejected upon an alleged obvious combination of HOSHIZAKI and BOURDEAU, specifies that the *dorsal portion* of the flexible frame is spaced above the outer sole.

The rejection of claim 33 is premised upon the removal of the "lower rear portion 6" of the HOSHIZAKI's rigid overlay 1 which is intended to rigidify the heel of the hockey boot of HOSHIZAKI.

Clearly, the removal of the rear portion 6 would be inconsistent with the objective of HOSHIZAKI. Accordingly, Applicant submits that the hypothetical modification of the boot of HOSHIZAKI by means of an alleged suggestion by BOURDEAU would not have been obvious to one skilled in the art. Therefore, at least for this reason, withdrawal of the rejection of claim 33 is requested.

Still further, for the boot of the invention, or with the boot of HOSHIZAKI, having no attachment means like that of BOURDEAU (see element 32 of BOURDEAU), there would have been no need to use the skeleton of BOURDEAU.

In addition, with no skeleton, there would have been no suggestion to one skilled in the art to have made the dorsal part of the plastic overlay of HOSHIZAKI higher in view of BOURDEAU.

SUMMARY AND CONCLUSION

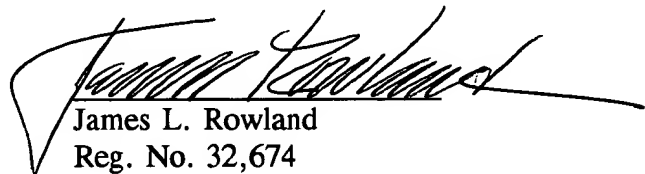
The grounds of rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

With the withdrawal of the rejections, Applicant also requests that withdrawn claims 19 and 20 be allowed together with the allowance of the claim from which they depend.

No extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicant requests an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) that would render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089. In addition, any additional required fee, such as a claim fee, can be charged to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
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Attachments A, B

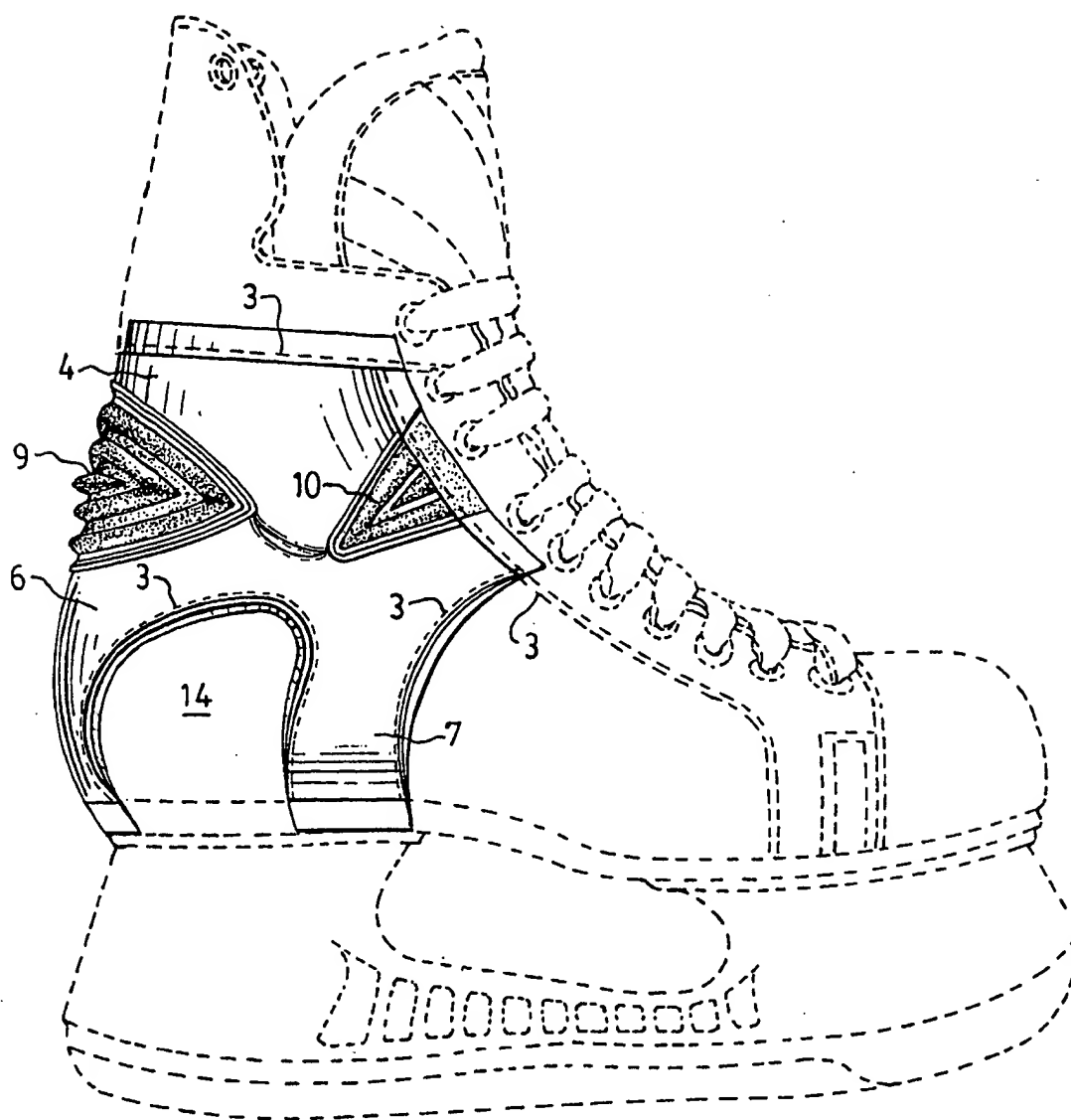
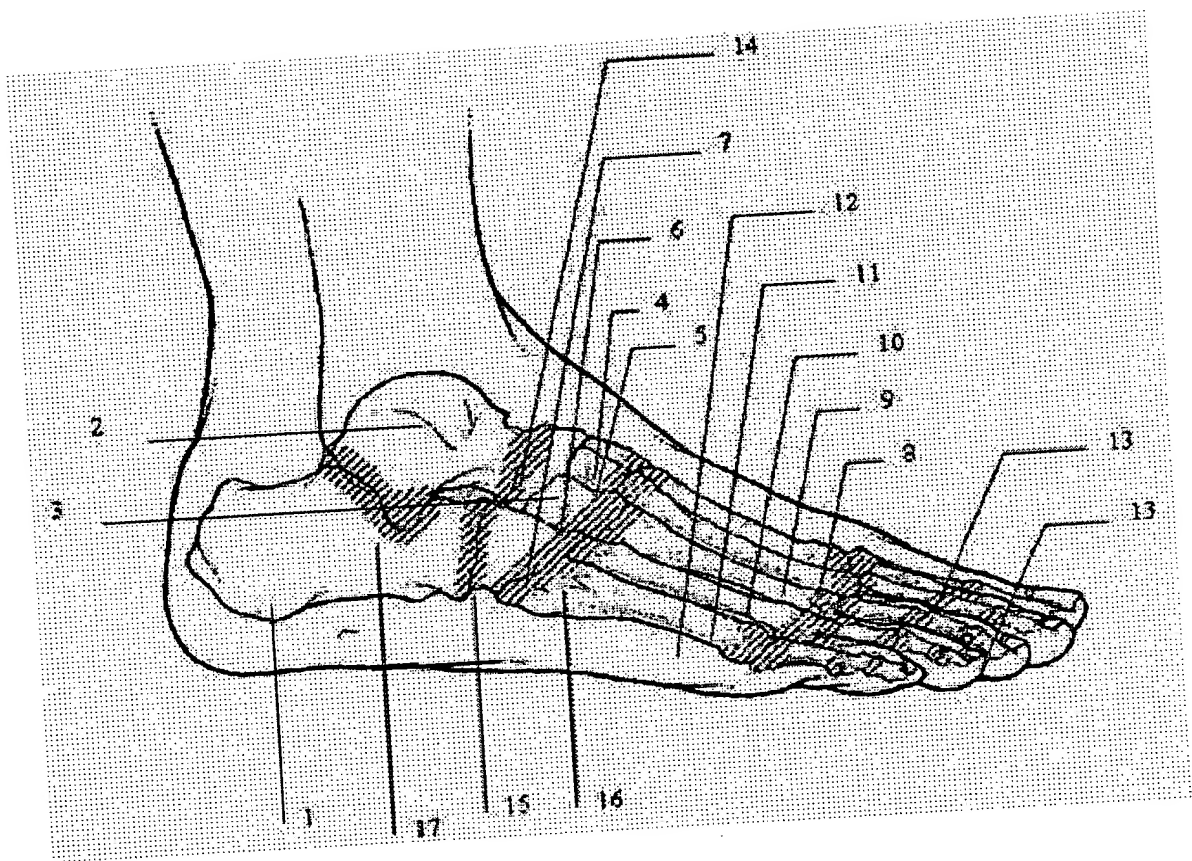


FIG.2.

ATTACHMENT A



ATTACHMENT B